

## REMARKS

Claims 1-11, 13-24, 26-59, 61-67, 69, 70, 73, 74 and 76-85 are pending in this application, of which Claims 7-11, 20-24, 26-37, 47, 48, 62 and 80 stand withdrawn from consideration as being drawn to non-elected species.

### §112 Rejection

By the above Amendment, Claim 83 has been amended to depend from Claim 81 rather than from Claim 82, thereby obviating the examiner's rejection of Claim 83 under 35 U.S.C. §112, second paragraph. Applicant thanks the examiner for pointing out this error in Claim 83.

### §103 Rejections

By the Office Action dated 9/7/2006, all pending elected claims have been rejected under 35 U.S.C. §103. Reconsideration of this application is respectfully requested in view of the following Remarks and the accompanying Supplemental Declaration Under 37 C.F.R. §1.132.

Applicant respectfully submits that all claims as presently amended are patentable over Neugebauer (U.S. Patent No. 5,522,163) in view of Wang (5,502,907), the references cited by the examiner in rejecting the pending elected claims, for the reasons discussed below.

The stated objective described in the Neugebauer patent is to provide “a *screw down card holder* having dimensions smaller than those of conventional screw down card holders” (Neugebauer at column 1 lines 44-46) which, “rather than having four screws, this card holder is closed by *one threaded fastener*” (Neugebauer at column 1 lines 65-67) [Emphasis added]. The Neugebauer patent essentializes the closure of the cover to the base as being obtained by a threaded fastener (see also, for example, the Neugebauer patent at column 1 lines 51-53 and at column 3 lines 11-20), as well as in the Neugebauer patent's prosecution history which distinguishes a frictional closure from the screw closure, stating that the frictional engagement system does not suggest the use of a threaded fastener and alignment apertures to effectuate a closure of the container” (Neugebauer prosecution history, page 6 of Amendment dated December 5, 1995). Accordingly, Neugebauer teaches that a threaded fastener is an essential element of the card holder disclosed in the Neugebauer patent, thereby teaching away from the substitution of a non-threaded fastener for the Neugebauer threaded fastener.

As noted by the Federal Circuit in *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed.Cir. 1998), “invention itself is the process of combining prior art in a non-obvious manner.” Applicant

submits that one of ordinary skill in the sports card holder art would not have been motivated to select the Wang reference and to combine its teachings with the Neugebauer reference to result in applicant's invention as claimed in applicant's independent Claims 1, 38, 49 and 63, particularly in view of the Neugebauer patent essentializing the threaded fastener and leading away from any such motivation. "[R]eferences that teach away cannot serve to create a *prima facie* case of obviousness." *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (Fed.Cir. 2001). See also *W.L. Gore. & Assoc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed.Cir 1983)

Accordingly, applicant submits that independent Claims 1, 38, 49 and 63, as well as all pending claims depending from these independent claims, are patentable over Neugebauer in view of Wang.

Dependent Claims 78, 81 and 84, depending respectively from Claims 1, 38 and 49, recite applicant's projecting end portion of one of the magnetic members and the recessed other one of the magnetic members, and the aligned indentation for receiving that projecting end portion. Claims 78, 81 and 84 are similar to Claims 1, 38 and 49 as amended in applicant's previous Amendment filed 8/4/2005, and the argument presented by applicant in that previous Amendment with respect to the previously amended Claims 1, 38 and 49 is repeated and incorporated herein by reference with respect to dependent Claims 78, 81 and 84. Accordingly, applicant submits that Claims 78, 81 and 84, as well as all claims depending therefrom, recite subject matter separately patentable over Neugebauer in view of Wang.

#### **Objective Evidence of Non-Obviousness**

Moreover, even assuming *arguendo* that the examiner has established a *prima facie* case of obviousness based upon the cited references, applicant has submitted in the Amendment dated 6/22/2006, and further submits herewith, objective evidence of non-obviousness for rebutting any possible *prima facie* case of obviousness. "Objective evidence of non-obviousness may be used to rebut a *prima facie* case of obviousness based on prior art references." *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed.Cir. 1999). Such objective evidence may include commercial success, copying and long-felt but unsolved need, *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed.Cir. 1998). Specifically, applicant submits the accompanying "Supplemental Declaration Under 35 C.F.R. §1.132" of

Bruce J. Greenbaum, President of applicant's assignee Ultra Pro L.P., supplementing Mr. Greenbaum's Declaration dated 6/19/2006 previously filed in this application by the Amendment dated 6/22/2006.

Applicant and his attorney thank Examiner Gary Hoge for his courtesies and assistance during a telephone interview on 9/27/2006 between the examiner and applicant's undersigned attorney, wherein Mr. Greenbaum's 6/19/2006 Declaration was discussed. During that interview, the examiner reconsidered the second objection expressed in the 9/7/2006 Office Action – that “the Declaration does not show that the objective evidence of non-obviousness is commensurate in scope with the claims” – and agreed that such objection is inappropriate since the Declaration indeed shows that the objective evidence is commensurate in scope with the claims recited in the application.

The examiner further expressed his belief that the objective evidence of the Declaration clearly demonstrates overwhelming commercial success of applicant's magnetic holder recited in the claims, but that the Declaration did not address the issue as to whether such commercial success may have been the result of a massive or intensive marketing campaign rather than the direct result of the claimed magnetic closure feature of applicant's magnetic card holder product. Objective evidence concerning this issue is presented in the accompanying Supplemental Declaration of Bruce J. Greenbaum.

Mr. Greenbaum's Supplemental Declaration relates that applicant's assignee Ultra Pro L.P. had followed a conservative advertising program with respect to the Ultra Pro magnetic holder (referred to as the magnetic ONE TOUCH card holder in the Supplemental Declaration). Exhibit A of the Supplemental Declaration identifies the advertisements (and their costs) which included the ONE TOUCH, placed by Ultra Pro during the time covered by Mr. Greenbaum's previous Declaration (from Ultra Pro's introduction of the magnetic ONE TOUCH card holder in 2003 through the first quarter of 2006). Copies of the advertisements listed in Exhibit A are attached as Exhibits B-F of the Supplemental Declaration.

As noted in paragraph 4 of the Supplemental Declaration, the first advertisement (appearing in the July 2004 issue of a baseball card magazine) was the only advertisement that was solely directed to the ONE TOUCH. The other advertisements (Exhibits B-F) included the ONE TOUCH as one of several (nine to twelve) other Ultra Pro sports-related products

(paragraphs 5 and 6 of the Supplemental Declaration). Paragraph 7 notes that, with respect to all of these advertisements, the cost attributable to advertising the magnetic ONE TOUCH card holder, for the entire period from its introduction in 2003 through the first quarter of 2006, was \$4,077 in the aggregate, representing only 0.68% of ONE TOUCH sales during that entire time period.

Paragraphs 8 and 9 of the Supplemental Declaration relate that, during the same time period, both the ONE TOUCH and the 1-screw screwdown card holders appeared together on the same page of Ultra Pro's catalog (see Exhibit G), and that the ONE TOUCH and the 1-screw screwdown card holders were sold in retail stores in comparable point-of-sale displays, typically placed side-by-side (Exhibit H).

In paragraph 10 of the Supplemental Declaration, Mr. Greenbaum states that the modest advertising for the magnetic ONE TOUCH card holder was directed primarily to make retailers and consumers aware of this new product; that card collectors are knowledgeably selective as concerning holders for displaying and storing their sports cards; and that the magnetic ONE TOUCH card holder is not the type of product that can be sold by advertising hyperbole. Mr. Greenbaum expresses his belief that card collectors are attracted to the magnetic ONE TOUCH card holder when they discover its convenient and effective magnetic closure; that such discovery by consumers is in most cases not the result of advertising but by word-of-mouth among card collectors and by becoming aware of the magnetic closure of the ONE TOUCH product at retail sports card outlets; and that after initial purchase, repeat sales of the ONE TOUCH are the usual consequence of such card collector consumers' actually experiencing the convenience and effectiveness of its magnetic closure.

Based upon the objective evidence provided Mr. Greenbaum's Supplemental Declaration, it is clear that the commercial success of Ultra Pro's magnetic card holder is not the result of any massive or extensive advertising campaign, but that the commercial success of the magnetic card holder is the direct result of its magnetic closure feature.

Mr. Greenbaum's previous Declaration, supplemented by his accompanying Supplemental Declaration, demonstrate commercial success of applicant's magnetic card holder and a nexus between such commercial success and the magnetic closure feature as recited in applicant's claims, as well as evidencing that applicant's magnetic holder satisfied a long-felt

but unsolved need for an alternative to the 1-screw screwdown card holder without the disadvantages inherent in a threaded screw closure. Further, as regarding nexus, the prominence of the magnetic closure feature in a competitor's recent magnetic holder advertising as discussed in paragraph 9 of the previous Declaration, creates an inference that links applicant's claimed invention to its commercial success to show non-obviousness, *Gambro Lundia AB v. Baxter Healthcare Corp.*, 42 USPQ2d 1378, 1384 (Fed.Cir. 1997).

In view of the foregoing, applicant respectfully submits that pending elected Claims 1-6, 13-19, 38-46, 49-59, 61, 63-67, 69, 70, 73, 74, 76-79 and 81-85 patentably distinguish over the references of record. Applicant further submits that independent Claims 1, 49 and 63 are generic to the species identified by the examiner as Species II, III and IV, and applicant requests reconsideration by the examiner of the pending claims of such additional species. Applicant respectfully requests issuance of a Notice of Allowance with respect to all claims pending in this application.

Respectfully submitted,

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David Weiss  
Registration No. 24,803  
Customer No. 36396  
Attorney for Applicant

12650 Riverside Drive, Suite 100  
North Hollywood, California 91607-3492  
Telephone (818) 755-4848